REMARKS

I.   35 U.S.C. § 102(e) Rejections of Independent Claims 1 and 6 Based on Aihara et al.

Independent Claims 1 and 6 each recite elements relating to a memory device that stores

program code and data, and a host device that requires the program code to read the data. These

claims were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,223,190

to Aihara et al. Applicants respectfully traverse the rejections because Aihara et al. does not

teach that "the host device requires the program code to read the data," as recited in independent

Claims 1 and 6.

Aihara et al. teaches a camera that can store, on a removable memory device, both an

image file (e.g., a picture) and an HTML file that references the image file. The memory device

can then be connected to a computer (the host device), and the host device can display a web

page based on the HTML file and the image file stored on the memory device. As noted in the

Office Action, the HTML file does not contain the image file itself, but rather a reference to the

image file stored on the memory device. To display the web page, the host device reads the

HTML file. When the host device reads the part of the HTML file that references the image file,

the host device retrieves the image file from the location specified in the HTML file. As also

noted in the Office Action, the image file can be a .gif file, which is a ubiquitous image file

format.

The basis of the rejection seems to be the assertion that "[t]he only means by which

Aihara suggests that a data [image] file may be retrieved from the memory device is by way of

the associated HTML file." Since the claim recites that "the host device requires the program

code to read the data," it appears that the Office Action is asserting that the computer in Aihara et

al. (the purported host device) requires the HTML file (the purport program code) to read the

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image file (the purported data). However, while the host device in Aihara et al. uses the HTML file to build a web page incorporating the image file, the host device does not *require* the HTML file to read the image file. As noted in the Office Action, the image file is a .gif file, which can be read by the host device without the use of the HTML file. Indeed, Aihara et al. teaches that the image file can be retrieved from the memory device without the use of the associated HTML file. Aihara et al. explains that, instead of creating the HTML file on the camera, the image file can be read by the host device from the camera, manipulated using image editing software on the host device, and then imported into a document editing application on the host device to generate an HTML file. Clearly, the host device does not require the HTML file to read the image file since the host device is reading the image file well before the HTML file is generated.

Because Aihara et al. does not teach a memory device that stores both data and program code that a host device requires to read the data, Applicants respectfully submit that Aihara et al. fails to anticipate independent Claims 1 and 6 and their dependent claims. Accordingly, Applicants respectfully request removal of the 35 U.S.C. § 102(e) rejections of based on Aihara et al.

II.   35 U.S.C. § 102(e) Rejections of Independent Claims 20 and 23 Based on Oki et al.

In the Office Action, independent Claims 20 and 23 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,523,117 to Oki et al. Independent Claim 20 recites "*with the host device*, decrypting the encrypted program code using the identifier," and independent Claim 23 recites "a second portion storing encrypted program code that can be decrypted *with a host device* connected with the solid-state memory device using the stored identifier." Applicants respectfully traverse the rejections because Oki et al. does not teach decrypting *with a host device*.

Oki et al. teaches a system in which a CD-ROM (or, perhaps alternatively, a memory device) is mounted in a user's personal computer (the host device). The host device communicates with a separate, external CD-ROM deciphering center, which, as indicted by its name, deciphers the CD-ROM. Accordingly, the information on the CD-ROM is deciphered with the external CD-ROM deciphering center — not with the host device, as recited in independent Claims 20 and 23. Accordingly, Applicants respectfully request removal of the 35 U.S.C. § 102(e) rejections of independent Claims 20 and 23 and their dependent claims.

III.   35 U.S.C. § 102(e) Rejections of Independent Claims 76 and 81 Based on Sarfati

Independent Claims 76 and 81 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,478,222 to Sarfati. Independent Claim 76 recites a solid-state memory device storing audio data and an audio player that is required by a host device to play the audio data. Independent Claim 81 recites a solid-state memory device storing video data and a video player that is required by a host device to play the video data. In the Office Action, it was asserted that col. 7, lines 10-31 of Sarfati teaches these elements. Applicants respectfully disagree. No where in this cited passage is a description of (1) a solid-state memory device storing audio data and an audio player that is required by a host device to play the audio data, as recited in independent Claim 76, or (2) a solid-state memory device storing video data and a video player that is required by a host device to play the video data, as recited in independent Claim 81. Accordingly, Applicants respectfully request removal of the 35 U.S.C. § 102(e) rejections of independent Claims 76 and 81 and their dependent claims.

IV.   Double Patenting Rejections

Several claims were rejected under the judicially-created doctrine of obviousness-type double patenting over various claims of U.S. Patent No. 6,778,974. Applicants respectfully submit that the rejection is not complete and, therefore, should be withdrawn.

MPEP 804 states that "[a]ny obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application . . . ." The rejection in the Office Action fails to meet this requirement. The Office Action states:

> Although the conflicting claims are not identical, they are not patentably distinct from each other because the '974 patent teaches to [sic] interfacing with a memory device comprising memory cells of a semiconductor material (see '974 patent, claim 20). It is well-known in the art to implement such memory as a solid-state device. All other limitations are present in the claims of the '974 patent.

Applicants respectfully submit that the citation of an element from a single claim — a dependent claim — does not make clear the differences between various other purportedly conflicting claims. Accordingly, Applicants respectfully request that the obviousness-type double patenting rejections be withdrawn.
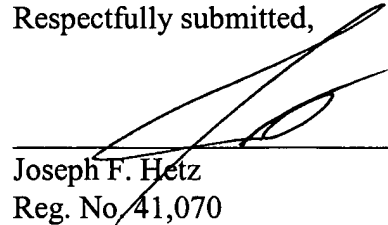
V.   Conclusion

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Reconsideration is respectfully submitted. Applicants note that while the above remarks focused on only some elements of the independent claims, other elements of the independent claims and the elements in the dependent claims provide additional grounds of patentability. Applicants expressly reserve the right to argue those additional grounds at a later time, if necessary.

If there are any questions concerning this Response, the Examiner is invited to contact the undersigned attorney at (312) 321-4719.

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